

SECTION II: REMARKS

A. Summary of Amendments

By the present submission, claims 2, 4, 6, 7, 14, 16, and 18 have been amended, and claims 1, 3, 13, and 15 have been cancelled.

Claims 2 and 6 have been amended to depend from claim 4, which has been recast in independent form to include the features originally presented in claims 1 and 3.

Claims 14 and 18 have been amended herewith to depend from claim 16, which has been recast in independent form to include all features originally presented in claims 13 and 15 (both cancelled herewith).

Claim 7 has been amended to correct a minor typographical error (i.e., addition of the word “and” in one clause thereof).

The foregoing amendments are fully consistent with and supported by the originally-filed specification. No new matter within the meaning of 35 U.S.C. 132(a) has been introduced.

B. Response to Claim Rejections Under 35 U.S.C. 102(e)

In the June 10, 2009 Office Action, claims 1-3, 6, 13-15 and 18 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 7,218,919 to Vaananen (hereinafter “Vaananen”). Such rejections are inapposite to the claims as amended herewith.

Independent claims 1 and 13, and dependent claims 3 and 15, have been cancelled; accordingly, the rejections of such claims are moot.

Claims 2 and 6 have been amended to depend from claim 4, which has been recast in independent form to include the features originally presented in claims 1 and 3 (both cancelled herewith). At page 5 of the June 5, 2009 Office Action, the examiner conceded that Vaananen fails to disclose any “international mobile subscriber identity (IMSI) address.” Amended claims 2 and 6 now requires (*inter alia*) “means for obtaining an international mobile subscriber identity (IMSI) address corresponding to the MSISDN from the core network, means for sending the obtained IMSI address to the core network,

and means for obtaining the Internet address corresponding to the IMSI from the core network.” Based on the examiner’s statement that Vaananen fails to disclose any IMSI address, claims 2 and 6 are patentably distinguished over Vaananen. Accordingly, withdrawal of the rejections of claims 2 and 6 under 35 U.S.C. 102(e) is warranted, and is respectfully requested.

Claims 14 and 18 have been amended herewith to depend from claim 16, which has been recast in independent form to include all features originally presented in claims 13 and 15 (both cancelled herewith). At page 5 of the June 5, 2009 Office Action, the examiner conceded that Vaananen fails to disclose any “international mobile subscriber identity (IMSI) address.” Claims 14 and 18 now require (*inter alia*) “(i) sending the MSISDN to a core network of a wireless network system, (ii) obtaining an international mobile subscriber identity (IMSI) address corresponding to the MSISDN from the core network, (iii) sending the obtained IMSI address to the core network, and (iv) obtaining the Internet address corresponding to the IMSI from the core network.” Based on the examiner’s statement that Vaananen fails to disclose any IMSI address, claims 14 and 19 are patentably distinguished over Vaananen. Accordingly, withdrawal of the rejections of claims 14 and 18 under 35 U.S.C. 102(e) is warranted, and is respectfully requested.

C. Response to Claim Rejections Under 35 U.S.C. 103(a)

The June 10, 2009 Office Action contained numerous rejections under 35 U.S.C. 103(a), including:

- a rejection of claims 4-5 and 16-17 as being unpatentable for obviousness over Vaananen in view of U.S. Patent No. 6,885,871 to Caloud (hereinafter, “Caloud”);
- a rejection of claims 7-9, 12, 19-21, and 24 as being unpatentable for obviousness over Vaananen in view of 3GPP TS 23,140 v4.4.0 (2001-09) (3rd Generation Partnership Project; Technical Specification Group Terminals; Multimedia Messaging Service (MMS); Functional description; Stage 2 (Release 4)” (hereinafter “3GPP MMS”); and
- a rejection of claims 10-11 and 22-23 as being unpatentable for obviousness over Vaananen and 3GPP MMS, further in view of Caloud.

Such rejections are traversed for the reasons set out below.

1. Law Regarding Obviousness Rejections

It is fundamental to a proper rejection of claims under 35 U.S.C. § 103 that an examiner must present a convincing line of reasoning supporting the rejection¹. The Supreme Court affirmed the validity of such approach, stating that “**there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**” *KSR International Co. v. Teleflex Inc.*, 127 S.Ct 1727, 167 L.Ed.2d 705, 82 USPQ2d 1385, 1396 (2007). In *KSR*, the Supreme Court further confirmed that **references that teach away from the invention are evidence of the non-obviousness** of a claimed invention², and reaffirmed the principle that a factfinder judging patentability “should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.”

Following *KSR*, the Federal Circuit held that although “rigid” application of the “teaching, suggestion, or motivation” (“TSM”) test for obviousness is improper, **application of a flexible TSM test remains the primary guarantee against improper “hindsight” analysis**, because a flexibly applied TSM test ensures that the obviousness analysis proceeds on the basis of evidence in existence before time the application was filed, as required by 35 U.S.C. § 103³.

In considering a reference for its effect on patentability, the reference is required to be considered in its entirety, including portions that teach away from the invention under consideration. Simply stated, the prior art must be considered as a whole⁴. “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of

¹ MPEP 2144 (“Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103”), citing *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985).

² *KSR*, 82 USPQ2d at 1395, 1399

³ *Ortho-McNeil Pharm. Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 86 USPQ2d 1196, 1201-02 (Fed. Cir. 2008).

⁴ *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (emphasis added); MPEP § 2141.02.

ordinary skill in the art⁵.” The Federal Circuit and its predecessor court have repeatedly held that **if references taken in combination would produce a ‘seemingly inoperative’ device, then such references teach away from the combination** and cannot serve as predicates for a *prima facie* case of obviousness⁶.

A suggestion to combine references **cannot require substantial reconstruction or redesign** of such references, **or a change in basic operating principles** of a construction of a reference, to arrive at the claimed invention⁷.

2. Disclosure of Vaananen

Vaananen discloses a wireless network system that enables direct wireless delivery of audio and/or video messages from a first user agent to a second user agent, and use of a lookup server to enable retrieval of a telephone number or an IP address of a recipient.

In the June 10, 2009 Office Action, the examiner conceded that Vaananen fails to disclose the following elements recited in Applicants’ claims:

- an international mobile subscriber identity (IMSI) address⁸;
- a home location register (HLR)⁹; and
- a first MMSE that is different from a second MMSE, and communication between two MMS servers¹⁰.

3. Disclosure of Caloud

In the Final Office Action dated April 27, 2008, the examiner stated that “[t]he communications gateway 128 is used to bridge the Internet network 106, to which the

⁵ *Application of Wesslau*, 353 F.2d 238, 241 (C.C.P.A. 1965); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve*, 796 F.2d 443, 448 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987).

⁶ *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001); *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999) (proposed combination of references that would be inoperable for intended purpose supports teaching away from combination); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away); *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969) (references teach away from combination if combination produces seemingly inoperative device)

⁷ *In re Ratti*, 270 F.2d 810, 123 USPQ 349, 352 (C.C.P.A. 1959).

⁸ June 10, 2009 Office Action, pages 5 and 9.

⁹ June 10, 2009 Office Action, pages 5 and 10.

¹⁰ June 10, 2009 Office Action, page 8.

personal computer 101 belongs, and the Cell network 118, to which the cell phone 108 belongs (see FIG. 1).” Caloud makes clear that all messages between the cell phone and the personal computer are received and forwarded by the internet gateway 128. In fact, Caloud teaches away from direct communication between the personal computer and the cell phone such that “[t]he gateway 128 is thus in a position to filter messages addressed to the terminal 108 and thus avoid undesirable messages.” (See, Col. 8, lines 61-63.) Since Caloud relies upon a gateway 128 that transmits and filters all messages between user agents, Caloud **teaches away** from any wireless network system that enables **direct** wireless delivery of a multimedia message from a first multimedia messaging service (MMS) user agent to a second MMS user agent, and from means for forwarding the obtained Internet address to the first MMS user agent to enable the first MMS user agent to wirelessly deliver the multimedia message **directly** to the second MMS user agent.

4. Disclosure of 3GPP MMS

3GPP MMS discloses architecture and operation of MMS networks. Such architecture *requires* use of a “MMS Relay/Server responsible for storage and handling of incoming and outgoing messages and for the transfer of messages between different messaging systems¹¹.” The mandatory nature of such a MMS Relay/Server is noted at page 18 of 3GPP MMS, which states: “[w]hen a user intends to send an MM to one or several destinations the **MM shall be submitted** to the originator MMS Relay/Server.” The routing function of the MMS Relay/Server is further emphasized at page 19 of 3GPP MMS, which states:

“Upon reception of an MM from an originator MMS User Agent ... [a] **MMS Relay/Server**:

* * *

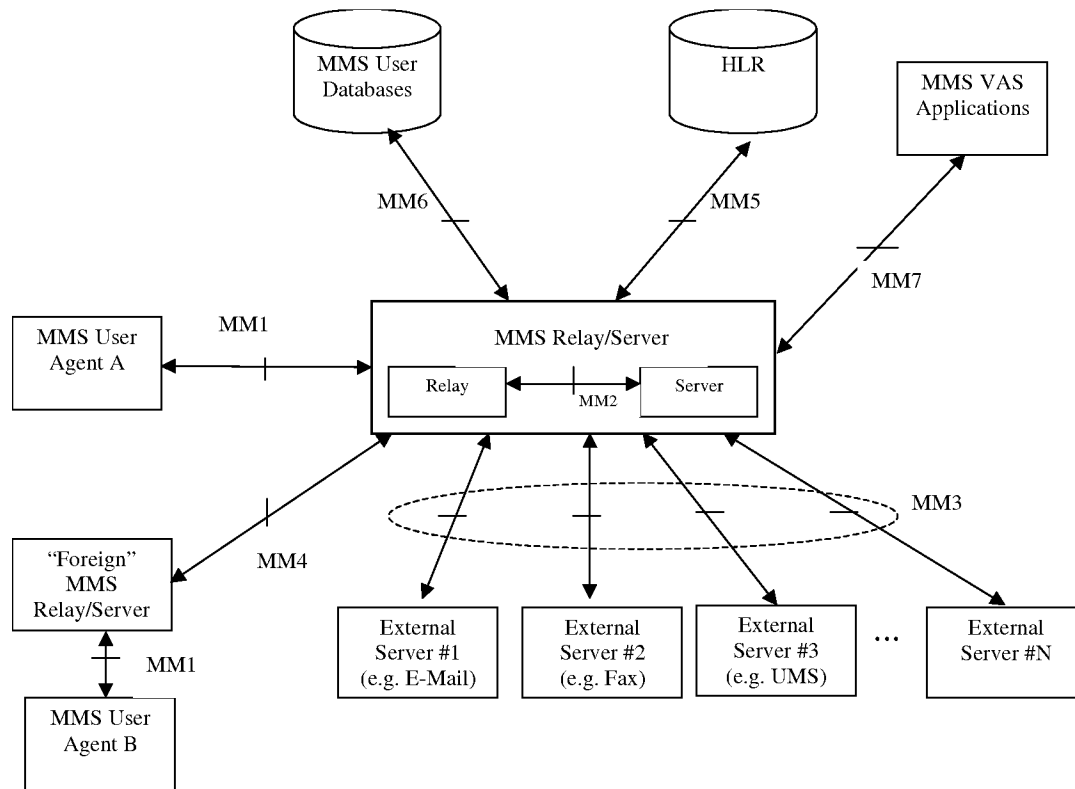
- is responsible for **retaining the MM until the earliest desired time of delivery**, if the optional feature of earliest time of delivery is supported by the originator MMS Relay/Server. If this feature is not supported then the MM is immediately routed forward, [and]

* * *

¹¹ 3GPP MMS, page 13.

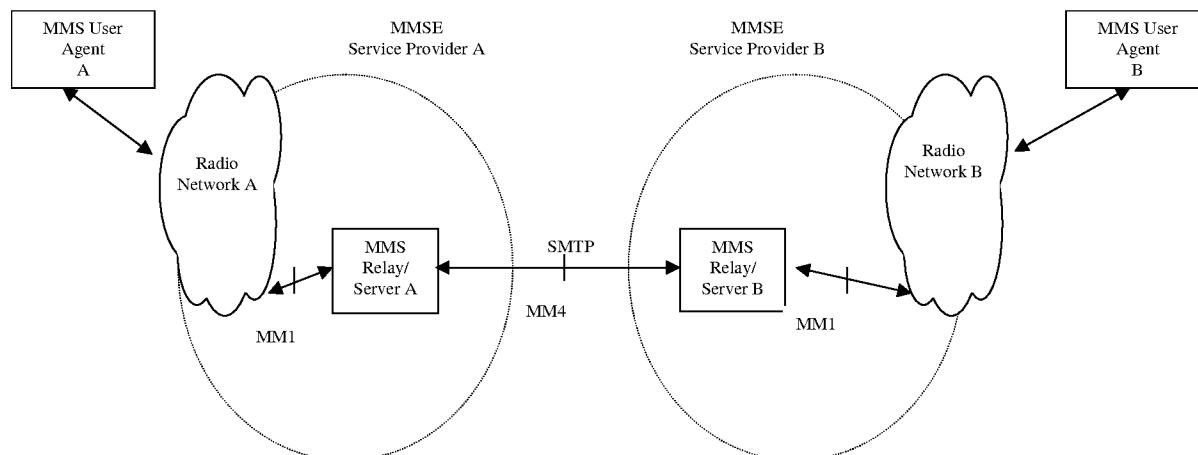
- is responsible to **route the MM towards the MM recipients ...**.”

MMS Reference Architecture consistent with the foregoing text is disclosed in 3GPP MMS at Figure 4 thereof, as reproduced below.



The foregoing excerpts from 3GPP MMS indicate that the MMS Relay/Server provides a primary message storage and routing function, and that all messages must be routed through a MMS Relay/Server.

3GPP MMS further discloses that messages may be transferred between multiple MMSE's, with reference to Figure 5 thereof, as reproduced below.



The foregoing Figure of 3GPP MMS again relies upon a MMS Relay/Server within each MMSE to provide a primary message routing and storage function.

5. Patentable Distinctions of Applicants' Claims Over the Cited Art

Upon entry of the present amendment, the present application includes four independent claims – namely, claims 4, 7, 16, and 19. The remaining claims all depend, whether directly or indirectly, from claims 4, 7, 16, or 19.

In the June 10, 2009 Office Action, the examiner alleged that, regarding claims 4 and 16¹², it would have been obvious to a person with ordinary skill in the art at the time the present invention was made to combine the teaching of Caloud with Vaananen's system to serve MMS User Agents across multiple MMSEs by interworking between international MMS service providers using IMSI, thereby increasing satisfaction/convenience for MMS users and revenues for MMS service providers¹³.

Applicant respectfully disagrees with the examiner's hypothetical combination of Caloud and Vaananen, since the disclosures provide contradictory teachings that do not support their combination. Caloud disclosed that a gateway 128 should be used as an intermediary between devices, to "filter messages" and thereby "avoid undesirable

¹² At page 6 of the June 10, 2009 Office Action, the examiner alleged that "[c]laims 16-17 are of the same scope as claims 4-5 respectively." Applicant respectfully disagrees. Although claims 4 and 16 have similar scope, the scope of each claim is not identical – not least of which for the reason that claim 4 is a system claim, and claim 16 is a method claim. Although common arguments distinguishing independent claims 4 and 16 over the cited art are made herewith, Applicant reserves the right to present independent and distinct arguments for patentability of claims 4 and 16, if necessary or desirable to do so in the future.

¹³ June 10, 2009 Office Action, page 5.

messages¹⁴.” In contrast, Vaananen discloses a wireless network system that enables direct wireless delivery of audio and/or video messages from a first user agent to a second user agent. Because Vaananen’s core teaching of direct wireless delivery from one user agent to another agent contradicts a core teaching of Caloud (requiring use of a gateway as an intermediary), such references are not properly combinable. Any hypothetical modification of Vaananen to incorporate the teachings of Caloud would require substantial reconstruction or redesign of Vaananen’s system, or a change in basic operating principles of Vaananen. It is well settled that a suggestion to combine references cannot require substantial reconstruction or redesign of such references, or a change in basic operating principles of a construction of a reference, to arrive at the claimed invention¹⁵.

Accordingly, the proposed combination of Caloud and Vaananen is defective, and cannot support a rejection of independent claims 4 or 16. Withdrawal of the rejections of independent claims 4 and 16 is warranted, and is respectfully requested.

Because dependent claims inherently include all the features of the claims on which they depend¹⁶, all claims depending (whether directly or indirectly) from independent claims 4 or 16 are likewise patentably distinguished over the cited art. Withdrawal of the rejections of all claims depending from independent claims 4 or 16 is warranted, and is respectfully requested.

In the June 10, 2009 Office Action at pages 6-7 thereof, with regard to Applicant’s claims 7 and 19¹⁷, the examiner alleged that Vaananen discloses “a first MMS server located in the first MMSE” and “a second MMS server located in the second MMSE.” One problem with this allegation is that the examiner points to the same “central lookup server or central server” at col. 2, lines 14-36 as embodying both a first

¹⁴ Caloud, col. 8, lines 61-63.

¹⁵ *In re Ratti*, 270 F.2d 810, 123 USPQ 349, 352 (C.C.P.A. 1959).

¹⁶ 35 U.S.C. 112, fourth paragraph.

¹⁷ At page 9 of the June 10, 2009 Office Action, the examiner alleged that “[c]laims 19-21 are of the same scope as claims 7-9 respectively.” Applicant respectfully disagrees. Although claims 7 and 19 have similar scope, the scope of each claim is not identical – not least of which for the reason that claim 7 is a system claim, and claim 19 is a method claim. Although common arguments distinguishing independent claims 7 and 19 over the cited art are made herewith, Applicant reserves the right to present independent and distinct arguments for patentability of claims 4 and 16, if necessary or desirable to do so in the future.

and second MMS servers located in different MMSEs. See the following excerpt from page 7 of the Office Action alleging that Vaananen discloses the following:

a first MMS server located in the first MMSE [col. 2, lines 14-36, the central lookup server or central server]; and

a second MMS server located in the second MMSE [col. 2, lines 14-36, the central lookup server or central server];

Col. 2, lines 28-36 of Vaananen indeed refers to “a [singular] central server” and “the central server.” This singular use of “a” and “the” with respect to the central server is consistent with usage of the term “central” as suggestive of unitary or singular (i.e., rather than distributed).

Importantly, nothing Vaananen refers to any first and second MMSE, let alone any first and second MMS server located in different MMSEs. To the contrary, Vaananen Figure 8 (reproduced below) suggests use of a single backup server 810 “for backup of messages” if direct exchange between subscriber terminals 820, 821, 822, 823 in the first instance is unsuccessful.

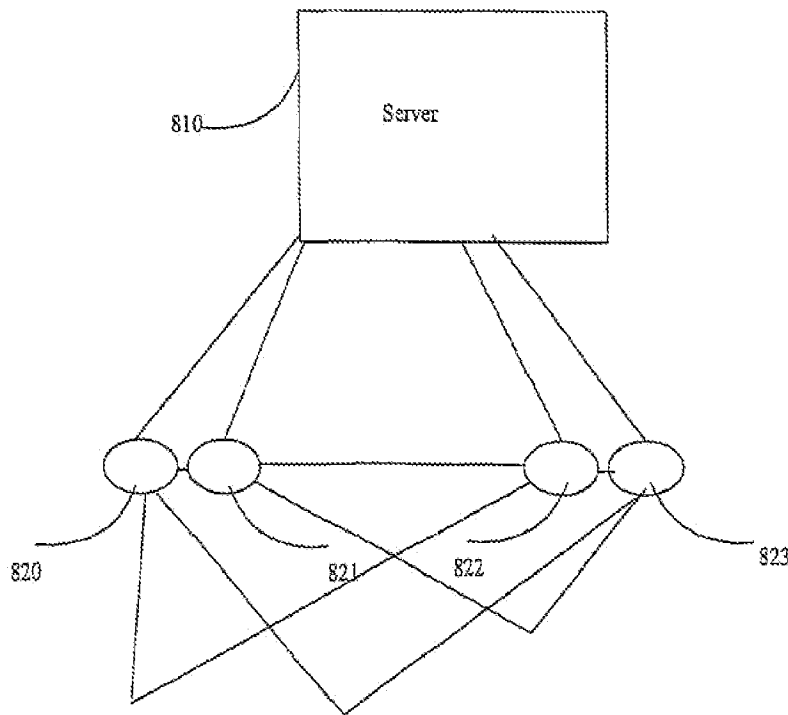


FIG 8.

At page 8 of the June 10, 2009 Office Action, the examiner contradicts the foregoing allegation regarding Vaananen's disclosure, and stated that "Vaananen discloses the claimed invention [of claims 7 and 19] except for the first MMSE is different from the second MMSE, and the communications between two MMS servers." The examiner then pointed to 3GPP MMS as disclosing interworking between different MMSEs including communication between different MMS servers based on SMTP, and alleged that "[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate 3GPP MMS' teaching into Vaananen's system for the purpose of serving MMS User Agents across different MMSEs by interworking between different MMS service providers, thereby increasing satisfaction/convenience for MMS users and revenues for MMS service providers."

Applicant respectfully disagrees with the examiner's hypothetical combination of Caloud and 3GPP MMS, since the disclosures provide contradictory teachings that do not support their combination. As discussed previously, 3GPP MMS at pages 18-19 thereof clearly discloses that all messages must be routed through a MMS Relay/Server. In contrast, Vaananen discloses a wireless network system that enables direct wireless

delivery of audio and/or video messages from a first user agent to a second user agent. Because Vaananen's core teaching of direct wireless delivery from one user agent to another agent contradicts a core teaching of 3GPP MMS (requiring use of a MMS Relay/Server to route all communications), such references are not properly combinable. Any hypothetical modification of Vaananen to incorporate the teachings of 3GPP MMS would require substantial reconstruction or redesign of Vaananen's system, or a change in basic operating principles of Vaananen. It is well settled that a suggestion to combine references cannot require substantial reconstruction or redesign of such references, or a change in basic operating principles of a construction of a reference, to arrive at the claimed invention¹⁸.

Accordingly, the proposed combination of 3GPP MMS and Vaananen is defective, and cannot support a rejection of independent claims 7 or 19. Withdrawal of the rejections of independent claims 7 and 19 is warranted, and is respectfully requested.

Because dependent claims inherently include all the features of the claims on which they depend¹⁹, all claims depending (whether directly or indirectly) from independent claims 7 or 19 are likewise patentably distinguished over the cited art. Withdrawal of the rejections of all claims depending from independent claims 4 or 16 is warranted, and is respectfully requested.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the now-pending claims are in condition for allowance. Examination of the enclosed claims and issuance of a notice of allowance are earnestly solicited. Should any issues remain that may be amenable to telephonic resolution, the examiner is invited to telephone the undersigned attorneys to resolve such issues as expeditiously as possible.

¹⁸ *In re Ratti*, 270 F.2d 810, 123 USPQ 349, 352 (C.C.P.A. 1959).

¹⁹ 35 U.S.C. 112, fourth paragraph.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 14-1270.

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